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09/439,343

11/15/1999

ANDREW L. DIRIENZO

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EXAMINER

AL HASHEMI, SANA A

ART UNIT

PAPER NUMBER

2156

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/439,343 | Applicant(s) DIRIENZO, ANDREW L. | |
| | Examiner Sana Al-Hashemi | Art Unit 2156 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 103-108, 112, 152, 153, 156-168, 170-175 and 177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 103-108, 112, 152-153, 156-168, 170-175, and 177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is issued in response to amendment/RCE filed 4/29/09.

Claims 1-102, 109-111, 113-151, were canceled. Claims 103-108, 112, 152-153, 156-168, 170-175, were amended. Claims 154-155, 169, 176, 178-196 were withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/09 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 106, and 108, the phrase "can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 103-108, 112, 152-153, 156-168, 170-175, and 177, are rejected under 35 USC 102(e) as being anticipated by Ballantyne et al. (Ballantyne hereinafter) US Patent No. 5,867,821 filed Feb. 16, 1999.

Regarding Claims 103, and 107, Ballantyne discloses a computer system operated by a first user, the computer system comprising:

Memory (Fig. 4, element 54, Ballantyne); and

software adapted to cause the computer system to store a plurality of links to respective digital information blocks, each digital information block is generated by an individual one of a plurality of second users of one or more second computers (Col. 5, lines 2-8, Ballantyne);

wherein each of the links is associated with a single one of the digital information blocks (Col. 4, lines 30-47, Ballantyne);

wherein each digital information block and its link are associated with at least one identifier (Col. 3, lines 64-65, Ballantyne);

wherein each of the links has associated with it a bid amount the respective one of the second users attaches to that link, and wherein each link and its associated bid amount are stored in the memory (Col. 4, lines 46-47, Ballantyne);

wherein a third computer of a third user is presented with a list of links, and wherein the list is ordered by the computer system, responsive to the software and to at

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least the bid amounts associated with the links by the respective second users (Col. 5, 25-29, Ballantyne); and

wherein the list of links is configured to permit a third user to select any one of the links and, by using the selected link, to download the digital information block associated with the selected link, for viewing data contained therein (Col. 5, lines 44-51, Ballantyne).

Regarding Claim 104, Ballantyne discloses a computer system wherein:
the digital information blocks each consist of one electronic file controlled by a respective one of the second users (Col. 6, lines 1-7, Ballantyne).

Regarding Claims 105, and 112, Ballantyne discloses a computer system wherein at least one of the electronic files comprises an electronic medical image (Col. 4, lines 3-5, Ballantyne).

Regarding Claims 106, and 108, Ballantyne discloses a computer system , wherein the bid amount associated with a link can be freely updated by the respective second user (Col. 6, lines 6-19, Ballantyne).

Regarding Claims 152, and 174, Ballantyne discloses a computer system wherein the ordering of the list of links is established by further using the electronic labeling of the digital information block (Col. 4, lines 17-29, wherein the identifying is a labeling, Ballantyne).

Regarding Claims 153, and 175, Ballantyne discloses a computer system wherein the electronic labeling includes at least one of the following: modality, subspecialty, speed of response by the third user, and body part (Col. 4, lines 30-45, Ballantyne).

Regarding Claim 156, Ballantyne discloses a computer system wherein the bid amount is paid when a third user selects a particular link, downloads the associated digital information

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block, and takes an action required by the second user associated with the selected link (Col. 4, lines 46-47, Ballantyne).

Regarding Claim 157, Ballantyne discloses a computer system wherein the action includes the third user entering information into a form (Col. 12, lines 48-51, Ballantyne).

Regarding Claim 158, Ballantyne discloses a computer system wherein the form is a medical diagnosis report (Col. 11, and 12, lines 67, 1-4, respectively, Ballantyne).

Regarding Claim 159, Ballantyne discloses a computer system wherein the first computer system is configured to receive a message indicating when the action is completed (Col. 12, lines 1-4, Ballantyne).

Regarding Claim 160, Ballantyne discloses a computer system wherein, for the plurality of links, each link and its associated at least one identifier are stored in at least one database (Col. 4, lines 40-45, Ballantyne).

Regarding Claim 161, Ballantyne discloses a computer system further comprising at least one communications subsystem for transmitting and receiving electronic communications from outside the computer system (Col. 12, lines 12-24, Ballantyne).

Regarding Claim 162, Ballantyne discloses a computer system wherein each link in the plurality of links is included in storage at a request of a second user (Col. 12, lines 15-24, wherein the PDA is a second user, Ballantyne).

Regarding Claim 163, Ballantyne discloses a computer system wherein the list of links is presented in response to the computer system receiving at least one identifier from the third computer (Col. 12, lines 25-34, Ballantyne).

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Regarding Claim 164, Ballantyne discloses a computer system wherein the software is further adapted to cause the computer system to store at least one of the digital information blocks (Col. 12, lines 35-41, Ballantyne).

Regarding Claims 165, and 177, Ballantyne discloses a computer system wherein the software is further adapted to cause the computer system to record when a link has been used and a digital information block has been downloaded (Col. 12, lines 37-41, Ballantyne).

Regarding Claim 166, Ballantyne discloses a computer wherein, for the plurality of links, each link and its associated at least one identifier are stored in at least one database (Col. 12, lines 40-47, Ballantyne).

Regarding Claim 167, Ballantyne discloses a computer system further comprising at least one communications subsystem for transmitting and receiving electronic communications from outside the computer system (Col. 12, lines 35-37, Ballantyne).

Regarding Claim 168, Ballantyne discloses a computer system wherein the list of links is presented in response to the computer system receiving at least one identifier from the third user (Col. 12, lines 35-37, Ballantyne).

Regarding Claim 170, Ballantyne discloses a computer system wherein the bid amount is paid when a third user selects a particular link, downloads the associated digital information block, and takes an action required by the second user associated with the selected link (Col. 17, lines 39-45, Ballantyne).

Regarding Claim 171, Ballantyne discloses a computer system wherein the action includes the third user entering information into a form (Col.13, 11-13, Ballantyne).

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Regarding Claim 172, Ballantyne discloses computer system wherein the form is a medical diagnosis report (Col. 13, 32-36, Ballantyne).

Regarding Claim 173, Ballantyne discloses a storage medium wherein the first computer system is configured to receive a message indicating when the action is completed (Col. 12, lines 48-55, Ballantyne).

Response to Arguments

Applicant's arguments with respect to claims 103-108, 112, 156-168, 170-175 have been considered but are moot in view of the new ground(s) of rejection.

It is a well settled rule that a reference must be considered not only for what it expressly teaches but also for what it fairly suggests. See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977) which indicates such fair suggestions to unpreferred embodiments must be considered even if they were not illustrated. Additionally, it is an equally well settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. See *In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956).

Point of Contact

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013.

The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pierre Vital can be reached on 571-272-4125. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sana Al-Hashemi/
Primary Examiner, Art Unit 2156
June 2, 2009